

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the drawings as failing to comply with 37 C.F.R. § 1.83(a)(4) because the drawings do not show every feature of the invention specified in the claims. Specifically, the Examiner argues that the motor must be shown or the features canceled from the claim. In response, claim 29 has been canceled, thereby rendering the objection to the Drawings moot. Consequently, the Examiner is respectfully requested to withdraw the objection to the drawings under 37 C.F.R. § 1.83(a)(4).

In the Official Action, the Examiner objects to claims 26 and 36. With regard to claim 26, the Examiner argues that the phrase “a rotating magnetic held” should be --a rotating magnetic field.” In response, claim 26 has been canceled, thereby rendering the rejection thereof moot.

With regard to claim 36, the Examiner argues that the phrase “a rising and failing angle” should be --a rising and falling angle--. In response, claim 36 has been amended as suggested by the Examiner.

Accordingly, it is respectfully requested that the objection to the claims be withdrawn.

In the Official Action, the Examiner rejects claims 21, 22, 32-35 and 37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,224,608 to Ciccolella et al., (hereinafter “Ciccolella”). Additionally, the Examiner rejects claims 21, 23-28, 31-33, 39, 40 and 43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0181788 to Yokoi et al., (hereinafter “Yokoi”) in view of Ciccolella. Furthermore, the Examiner rejects claim 29 under 35 U.S.C. § 103(a) as being unpatentable

over Yokoi and Ciccilella and further in view of U.S. Patent Application Publication No. 2005/0143644 to Gilad (hereinafter "Gilad"). Still further, the Examiner rejects claim 36 under 35 U.S.C. § 103(a) as being unpatentable over Ciccilella in view of U.S. Patent Application Publication No. 2003/0065361 to Dreyfuss (hereinafter "Dreyfuss"). Still further, the Examiner rejects claim 37 under 35 U.S.C. § 103(a) as being unpatentable over Yokoi and Ciccilella and further in view of U.S. Patent Application Publication No. 2003/0060734 to Yokoi (hereinafter "Yokoi '734"). Still further, the Examiner rejects claim 38 under 35 U.S.C. § 103(a) as being unpatentable over Ciccilella in view of U.S. Patent No. 5,954,714 to Saadat et al., (hereinafter "Saadat"). Still further yet, the Examiner rejects claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Ciccilella in view of U.S. Patent Application Publication No. 2003/0009222 to Fruh et al., (hereinafter "Fruh"). Lastly, the Examiner rejects claim 42 under 35 U.S.C. § 103(a) as being unpatentable over Ciccilella in view of U.S. Patent Application Publication No. 2005/0031665 to Watson et al., (hereinafter "Watson").

Firstly, claims 22, 26 and 29 have been canceled, thereby rendering the rejections thereof moot.

In the Official Action, the Examiner argues with regard to claim 22, that "while Ciccolella et al., does not explicitly disclose a rotational speed for his device, if the device is rotated by hand, it inherently has the capability of rotating at any speed-including a speed of not more than 5 rotations per second."

Thus, claim 21 has been amended to include features from claim 22, claim 22 has been canceled and claim 21 has been further amended to clarify that in contrast to being rotated by hand, the rotating device is configured such that a magnet arranged in the intra-

body medical apparatus is driven to rotate by a magnetic field generating device arranged outside the body that generates a rotating magnetic field.

The resulting recited apparatus of claim 21 is not disclosed or suggested in the prior art and achieves advantages not disclosed or contemplated by the prior art. Namely, the medical apparatus is allowed to rotate and thrust while preventing rotation failures (as shown in Figure 15a of the present application).

With regard to the rejection of claims 21, 22, 32-35 and 37 under 35 U.S.C. § 102(b), a medical apparatus having the features discussed above and as recited in independent claim 21, is nowhere disclosed in Ciccolella. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 21 is not anticipated by Ciccolella. Accordingly, independent claim 21 patentably distinguishes over Ciccolella and is allowable. Claims 32-35 and 37 being dependent upon claim 21, are thus at least allowable therewith (claim 22 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 21, 22, 32-35 and 37 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 21, 23-28, 31-33, 39, 40 and 43 under 35 U.S.C. § 103(a), independent claim 21 is not rendered obvious by the cited references because neither the Yokoi patent application nor the Ciccolella patent, whether taken alone or in combination, teach or suggest a medical apparatus having the features discussed above and recited in independent claim 21. Accordingly, claim 21 patentably distinguishes over the prior art and is allowable. Claims 23-25, 27, 28, 31-33, 39, 40 and 43, being dependent upon claim

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

21, are thus at least allowable therewith (claim 26 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 21, 23-28, 31-33, 39, 40 and 43 under 35 U.S.C. § 103(a).

With regard to the rejections of claims 36-38, 41 and 42 under 35 U.S.C. § 103(a), since independent claim 21 patentably distinguishes over the prior art and is allowable, claims 36-38, 41 and 42 are at least allowable therewith as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 36-38, 41 and 42 under 35 U.S.C. § 103(a).

Furthermore, new claim 47 has been added to further define the patentable invention. New claim 47 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 47. Applicants respectfully submit that new claim 47 is at least allowable as depending upon an allowable base claim (21).

Lastly, the specification has been reviewed for spelling and grammatical errors as well as for inconsistencies with the drawings. Any such errors and inconsistencies have been corrected by way of the present amendment. Specifically, the specification has been corrected at line 1 of page 34 to correct an inconsistency with the drawings and the Abstract has been amended to remove a reference numeral therefrom. A clean copy of the amended Abstract is provided on a separate sheet.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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Enclosure (Substitute Abstract)